

**Remarks**

Entry of the amendment is respectfully requested. No new matter has been added.

Reconsideration is respectfully requested.

**Claim Status**

In the Action, claim 9 is objected to because of an informality.

Claims 1, 17-19, and 22-23 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Fukatsu (U.S. Patent 4,510,381).

Claims 2 and 24-25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Fukatsu. Claims 26-28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Fukatsu in view of Shepherd (U.S. Patent 6,494,364).

Claims 3-16, 20, 21, and 29-34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The early indication of allowable subject matter is appreciated.

**The Claim Amendments**

Claim 1 has been amended to recite "wherein the at least one action includes attempting to move the gate".

Claim 2 has been amended to characterize the gate movement as toward the open position and the closed position.

Claim 3 has been amended to depend from claim 1, as amended.

Claim 4 has been amended to depend from new claim 35, therefore the scope of claim 4 has not been altered.

Claim 9 has been amended to correct an informality.

Claim 22 has been amended to clarify that the sensed profile of current verses time is indicative of a characteristic of an obstruction encountered by the gate, i.e., whether the obstruction is a hard obstruction or a soft obstruction.

Claims 24-26 have been amended to each depend from claim 36, which has been deemed allowable.

Claim 29 has been amended to correct an informality.

New claim 35 incorporates the subject matter of claim 3, and those from which it depends, which the Examiner indicated as allowable.

New claim 36 incorporates the subject matter of claim 20, and those from which it depends, which the Examiner indicated as allowable.

New claim 37 incorporates the subject matter of claim 21, and those from which it depends, which the Examiner indicated as allowable.

New claims 38-43, incorporate the subject matter of claims 29-34, respectively, and those from which each depends, which the Examiner indicated as allowable.

New claim 44 is drafted in *Markush* format listing a group of various actions able to be performed by the machine. Each listed action includes subject matter previously deemed allowable by the Examiner.

**35 U.S.C. § 102 Rejections: The Applicable Legal Standards**

Anticipation pursuant to 35 U.S.C. § 102 requires that a single prior art reference contain all the elements of the claimed invention arranged in the manner recited in the claim. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193, 198 (Fed. Cir. 1983).

Anticipation under 35 U.S.C. § 102 requires in a single prior art disclosure, each and every element of the claimed invention arranged in a manner such that the reference would literally infringe the claims at issue if made later in time. *Lewmar Marine, Inc. v. Barient, Inc.*, 822 F.2d 744, 747, 3 USPQ 2d 1766, 1768 (Fed. Cir. 1987).

Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. *RCA Corp. v. Applied Digital Data Sys., Inc.*, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

### Claim 1

Claim 1 has been amended to recite, "wherein the at least one action includes attempting to move the gate." This feature is similar to the recitation in claim 2, as originally filed. The following comments are thus directed at the Examiner's rejection of both claims 1 and 2 in view of Fukatsu. The recitation of "attempting to move the gate", as disclosed in Applicants' specification at page 68, line 22-page 69, line 1, distinguishes from Fukatsu.

As taught by Fukatsu, if a user's hand is caught between the shutter 15, the roller 196 slips relative to the member 15a, thus overloading the motor 194. The current in the driver 217 increases and if it exceeds a level (FIG. 19), a stop signal is provided to stop the shutter so that the user can remove the hand. The Examiner correctly describes this functioning of Fukatsu in the Action, page 3.

The Examiner further relates that Fukatsu is silent about attempting to move the gate. (Action, page 4). Fukatsu does not teach moving the gate away from the closed position "in order to provide some space/wiggle room for the user to remove their (sic) hand without injury or difficulty." (Action, page 4). Instead, Fukatsu teaches that the shutter movement stops while the

hand is only “weakly held” to allow the user to remove the hand. (Col. 16, lines 3-12). The Examiner’s modification of the reference (i.e., to reverse direction of the shutter) is not supported by the reference itself.

Also, “attempting to move the gate” and “stopping the shutter” are completely opposite actions. The reference therefore does not function in the manner recited in the claim. The reference teaches away from the claimed invention. Thus, claim 1, as amended, is not taught by or obvious over the cited reference.

Further, Fukatsu provides no teaching whatsoever about attempting to move the gate toward the closed position if an obstruction is detected. Even the Examiner’s reasoning fails to include an attempt to close the gate upon encountering an obstruction.

Claim 1 includes the feature of “attempting to move the gate” which is not taught or fairly suggested by the reference. Thus, claim 1, as amended, is not anticipated by, nor obvious in view of, Fukatsu. It is requested that the rejection of claim 1 be withdrawn.

#### Claims 17-19

Claims 17-19 each ultimately depend from claim 1. Thus the comments directed toward claim 1 are equally applicable to claims 17-19 and are incorporated herein by reference.

#### Claim 22

Claim 22 has been amended to recite, “(c) analyzing the at least one parameter monitored in (b) as a function of time through operation of at least one controller in the machine, including determining at least one sensed profile of current verses time, wherein the sensed current verses time profile is indicative of whether the gate has encountered a hard or soft obstruction in

attempting to move toward the closed position..." The amendment to claim 22 is supported in Applicants' specification at page 69, lines 4-17.

Fukatsu does not teach analysis of the profile, such as shown in Figure 19, to determine if the shutter 15 has encountered a hard object (such as a fraudulent tool) or a soft object (such as a hand). Thus, Fukatsu does not anticipate claim 22, as amended. Fukatsu does not lead one of ordinary skill in the art to analyze the profile, such as shown in Figure 19, to determine if the encountered object is a hard object or a soft object. Thus, Fukatsu does not render the claim obvious. It is requested that the rejection of claim 22 be withdrawn.

#### **Claim 23**

Claim 23 depends from claim 22. As such, the comments directed to claim 22 are incorporated herein by reference. In addition, claim 23 recites that "in (d) the action is taken depending on whether the gate has encountered a hard or soft obstruction as determined in (c)." Because Fukatsu does not differentiate between the shutter 15 encountering a hard obstruction or a soft obstruction, it necessarily cannot teach that the action taken by the machine is dependent on the type of obstruction. Further, there is no suggestion to modify the reference in order to arrive at Applicants' claim. Therefore, it is requested that the rejection of claim 23 be withdrawn.

#### **35 U.S.C. § 103 Rejections: The Applicable Legal Standards**

The Office has the responsibility to present a *prima facie* case of obviousness under 35 U.S.C. § 103. An Applicant is entitled to a patent if the Office fails to establish a *prima facie* case of obviousness. *In re Oetiker*, 24 USPQ 2d 1443 9Fed. Cir. 1992). In determining obviousness under 35 U.S.C. § 103, the invention must be considered "as a whole."

Any modification of the cited reference in order to arrive at Applicant's invention must be motivated by the cited art. *In re Deminski*, 230 USPQ 313 (Fed. Cir. 1986). Applicant's own disclosure may not serve as a template to piece together the teachings of the prior art to render the claimed invention obvious. *In re Fitch*, 23 USPQ 2d 1780 (Fed. Cir. 1992). There must be a reason or suggestion in the prior art for selecting the claimed procedure, other than knowledge learned from Applicant's disclosure. *In re Dow Chemical*, 5 USPQ 2d 1529 (Fed. Cir. 1988). Further, the motivation for modifying a reference cannot be found if the reference actually "teaches away" from the claimed invention. *In re Gurley*, 31 USPQ 2d 130 (Fed. Cir. 1994).

#### **Claim 2**

Claim 2 has been amended to characterize the gate movement as toward the open position and the closed position. Fukatsu does not provide any teaching or suggestion of moving the gate in the manner claimed.

#### **Claims 24-28**

Claims 24-28 have each been amended to either directly or ultimately depend from new claim 36, incorporating the subject matter of original claim 20, deemed allowable by the Examiner. Thus, it is believed that claims 24-28 are allowable on that basis. It is therefore requested that the rejections of claim 24-28 be withdrawn.

#### **Additional Comments**

Applicants have not necessarily presented all of the reasons as to why the references do not anticipate the claims nor render the claimed invention obvious. Nevertheless, Applicants' remarks herein have shown that Applicants' claims includes features and relationships not shown or suggested by the cited references.

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Further, Applicants have not specifically addressed the additional features included in many of the dependent claims. However, the dependent claims further define characteristics of the independent claims, which have been shown to be allowable. Thus, it is respectfully submitted that the rejections should be withdrawn.

**Claim Fees**

Please charge fees for nine (9) additional independent claim(s) (in excess of three) at \$200 each, and fees for 10 additional claim(s) at \$50 each for a total of \$2300 to Deposit Account No. 09-0428 (Diebold Self-Service Systems).

**Conclusion**

Each of Applicants' claims have been shown to be allowable over the cited references. Thus, it is believed that the application is in condition for allowance. The undersigned will be happy to discuss any aspect of the Application by telephone at the Office's convenience.

Respectfully submitted,



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